While the solution of wetting agent injected into the holes in Respondents' material initially soaks into the foam, as it does when sprayed onto the blocks or chunks shown in the patent, the drying concentrates the wetting agent in layers on the surfaces of the holes, just as it does on the surfaces of the block or the irregular surfaces shown in the patent (34a, 48a, 99a; 109a, ll. 67-69).

Thus in the Respondents' block, as in the patented block, the wetting agent concentrates in layers on surfaces of the foam which are positioned to contact water when the blocks are immersed in water.

When either of the blocks are completely saturated with water the concentration of the dissolved wetting agent diminishes throughout the mass of foam (38a). Both parties use only the minimum amount of wetting agent necessary to obtain complete saturation (93a). Thus, both parties have insufficient wetting agent in the saturated blocks to injure the flowers; but before saturation both parties have dried layers of wetting agent on surfaces accessible to the water, the layers being sufficiently concentrated to cause the water to penetrate and be carried into the foam.

As the District Court found, in Respondents' blocks the water enters the perforations and contacts the dried wetting agent "after which water is quickly drawn into the interior of the mass of foam" (A 7).

The only difference between the foams of the Petitioner and the Respondents is that Respondents have relocated the dried layers of wetting agent on the surfaces of holes recessed into the block for the purposes of appropriating the Petitioner's invention and avoiding liability by the pretense that these surfaces of the holes are not part of the "exterior" of the foam because they are recessed into the "inside" of the block.

Protection of Surfaces Subjected to Handling Is Not Claimed.

The patent claims are limited to layers of wetting agent of such concentration and location as to draw water into the interior of the foam, and the wetting agent in the Respondents' product is so located and concentrated. None of the claims are directed to layers of wetting agent of such a nature and location as to act as a binder on portions of the foam subjected to handling (R. B. 3, 4, 6, 7, 9), although this function is mentioned in the specification of the patent. It was also mentioned in some of the solicitor's arguments, but no claims were granted on this feature. Therefore, none of the claims which were granted are avoided by locating the wetting agent on surfaces not subjected to handling, because infringement is measured by the claims, not the specification (*Smith v. Snow*, 294 U. S. 1, 11).

Respondents' Arguments Shift from the Decisions Below to a Different Cancelled Claim.

The District Court and the Court of Appeals found estoppel based on the cancellation in the abandoned parent application of claim 1, limited to a foam with "wetting agent carried in the cells thereof" (A 10).

There was no finding of estoppel based on cancelled claim 2 now relied on by Respondents (R. B. 6, 10). This was necessarily true because to the extent claim 2 might have covered a layer of wetting agent on an exterior surface of the foam accessible to water this feature was not abandoned, but was insisted upon and granted in the claims in suit.

The cancelled claim 1 described inoperative wetting agent carried in the cells of the foam. Respondents' asser-

tion (R. B. 8) that the first mention of inoperative wetting agent in the cells was in the amendment in the parent application (136a) is wrong. It is described in the prior art patents on which the Examiner rejected claim 1. These disclosed mixing wetting agent in the resin before it is foamed, thereby producing foam with wetting agent "in the cells thereof," which is admittedly inoperative to cause water to soak into the foam. As the District Court held in footnote 6 (A 6) this wetting agent "remains within the cells" of the foam but is not active to cause wetting. The original claim 1, calling for wetting agent "carried in the cells," was properly rejected and cancelled because this was old and does not work. But it is a travesty to hold, as the Courts below did, that cancellation of this claim to an old and inoperative thing is an abandonment of all equivalents of the granted claims covering the patentee's new discovery which does work and which achieves new results.

Since the cancelled claim described a thing which does not work, it is self-evident that a construction of the granted claims to cover the Respondents' foam, which does work, is not a recapture of the disclaimed subject-matter of the cancelled claim—the evil intended to be prevented by the file wrapper estoppel rule.

The Conflict With Other Circuits Is Clear.

Respondents' assertions (R. B. 9, 13) that there is no conflict with other Circuits is unsupported. There is no dispute in Respondents' brief of the direct conflict of the decision of the Courts below with the decisions of the Court of Appeals for the Sixth Circuit (*Southern Textile Machinery Co. v. United Hosiery Mills Corp.*, 33 F. 2d 862, 866; *Farrington v. Haywood*, 35 F. 2d 628, 630-631) and

the Court of Appeals for the Fifth Circuit (*Hunt Tool Co. v. Lawrence,* 242 F. 2d 347, 354). Likewise, there is no dispute of the conflict with the ruling of the Second Circuit (*Musher Foundation Inc. v. Alba Trading Co.,* 150 F. 2d 885, 888) except to point out that in that case the Court additionally found no estoppel on another ground.

In these two decisions in the Sixth Circuit the Court held the granted claims to be infringed by equivalents which were not equivalents of the cancelled claims. In the Fifth Circuit decision the Court held the granted claims were infringed by equivalent structures so long as those were not the same as, or equivalents of, the prior art on which the cancelled claims had been rejected.

The decision of the Courts below in the instant case, on the contrary, hold the patentee forfeited all right to protection against equivalent re-locations of the exterior layers of wetting agent because of the cancellation of a claim which did not include an exterior layer, and which read upon prior art foams completely inoperative to achieve the new result of the patent. The accused foam which is operative and which does achieve the results of the patent (A 5-A 6) is not the equivalent of the inoperative prior art foams or the cancelled claim which read upon these inoperative prior art foams.

The subject-matter of the granted claims was not abandoned; on the contrary, it was persisted in and allowed. The cancellation of original claim 2 which was unpatentable for other reasons did not abandon the granted subject-matter even though wetting agent on the exterior of the foam was included in that claim.

Thus, on Respondents' own argument (R. B. 13) the decisions of the Courts below are also in direct conflict with the decision in *New York Scaffolding v. Whitney,* 224 Fed. 452, C. A. 8.

Nor is the decision of the Courts below in any way supported by this Court's decisions in *I. T. S. Rubber Co. v. Essex Rubber Co.*, 272 U. S. 429 or *Exhibit Supply Co. v. Ace*, 315 U. S. 126 (R. B. 9-12). In the former, this Court held (272 U. S. at page 443):

> "The patentee is thereafter estopped to claim the benefit of his rejected claim or such a construction of his amended claim as would be equivalent thereto."

Construing the granted claims to cover the accused *operative* foam does not make them equivalent to the cancelled claim covering *inoperative* foams.

In the second of these cases, this Court held (315 U. S. at page 136) that subject-matter disclaimed "cannot now be regained." Petitioner is not seeking to regain the inoperative subject-matter of the cancelled claims.

The Conflict With the Statute Is Clear.

Respondent (R. B. 13) mis-interprets the Statute (35 U. S. C. 112) as being limited to claims which include the *word* "means." But this is not the language of the Statute. Instead, the Statute provides that an element in a combination claim may be expressed as "a means" for performing a particular function without reciting all structure necessary to the function. The noun "means" as used in the Statute connotes "that through which, or by the help of which, an end is attained" (*Webster's New International Dictionary*, Second Edition). Such a "means" can be described in any appropriate language and then further limited, as in the claims in suit, by the functional clause "adapted to carry water into the interior of the mass." This functional clause defines the "layer" on the "exterior of the mass" of foam as being so located as to be accessible

to the water and of sufficient concentration to carry water into the interior of the mass of foam.

The Statute says this claim "shall be construed to cover" the corresponding structure described in the specification and also "equivalents thereof." The decision of the Courts below is exactly contrary to this mandatory provision of the Statute, holding instead that the claims cover the layers on the flat surfaces of the block described in the specification but do not cover equivalent locations of those layers on surfaces recessed into the outline of the block.

Respectfully submitted,

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